

REMARKS

Introductory Comments

In the non-final office action mailed October 31, 2006, claims 1-54 were pending, claims 50-54 were withdrawn from consideration, and claims 1-49 were rejected. With this response, claims 50-54 have been cancelled without disclaimer or waiver of the subject matter recited therein for possible submission in a divisional application. Claims 1-49 are currently pending and claim 46 has been amended. In view of the following remarks, reconsideration and allowance of the present application are hereby requested.

Claim Rejections

Claims 1-8, 16-21, 26-31, 36-41 and 46-49 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,185,356 to Parker et al. (hereafter "the '356 patent"). Claims 1-2, 4-8, 16-21, 26-27, 29-31, 36-37, 39-41 and 46 stand rejected under U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,796,214 to Davis (hereafter "the '214 patent"). Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the '356 patent in view of U.S. Patent No. 3,807,393 to McDonald (hereafter "the '393 patent"). Claims 9-14, 22, 24, 32-34 and 42-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the '356 patent alone. Claims 15, 25, 35 and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the '356 patent in view of U.S. Patent No. 5,293,863 to Zhu et al. (hereafter "the '863 patent").

35 U.S.C. §102(b) Rejections

It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed.

Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

As indicated above, claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by both the '356 patent and the '214 patent. Independent claim 1 is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, amongst other features, a retractor including an inner wall surface and a lighting element including at least one wall member, "said at least one wall member positionable along said inner wall surface and frictionally engageable with said inner wall surface, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor."

The Applicants respectfully submit that neither the '356 patent nor the '214 patent disclose, teach or suggest these claimed features. Specifically, the '356 patent discloses an accessory device 2860 in the form of a retractor blade which may be attached to protective cover 2800 of a light source through an attachment member 2850. The '356 patent further discloses that "[a]ttachment member 2850 can take a variety of suitable forms, including adhesive tape, Velcro fasteners, clips, hooks, tabs, clamps, snaps and the like." See col. 18, lines 52-54. Furthermore, the '356 patent also discloses that "protective cover 2850 [sic] may suitably include molded clips, hooks, tabs, or the like, for the attachment of an accessory." To that end, it is submitted that at least one wall member of the light transmitting member 2810 of the '356 patent is not frictionally engageable with the accessory device 2860. Instead, as indicated above, the '356 patent relies on a mechanical or adhesive connection to attach the light transmitting member 2810 to the accessory device 2860. Moreover, since the '356 patent does not teach or suggest that at least one wall member of the light transmitting member 2810 and the accessory device 2860 are frictionally engageable, it also can not teach or suggest "frictional engagement sufficient to maintain a position" of the light transmitting member 2810 relative to the accessory device 2860. Therefore, for at least these reasons, the '356 patent does not disclose the features of claim 1.

With regard to the '214 patent, it discloses a perineal retractor 10 including a blade 12 to which tubular members 50, 51 may be engaged. However, instead of disclosing that at least one wall member of the tubular members 50, 51 is frictionally engageable to the retractor 10, the

'214 patent discloses that "[t]he tubular members may be joined to the blade by any conventional technique, such as soldering". See column 3, lines 32-33. As one having skill in the art would appreciate, soldering the tubular members 50, 51 to the blade 12 fixes the members together through fusion, indicating that the components are not frictionally engageable. Moreover, since the '214 patent does not disclose that at least one wall member of the tubular members 50, 51 and the retractor 10 are frictionally engageable, it also does not disclose "frictional engagement sufficient to maintain a position" of the tubular members 50, 51 relative to the retractor 10. Therefore, the '214 patent also does not disclose all the features of claim 1.

Accordingly, the Applicants respectfully request withdrawal of the rejection of independent claim 1 as being anticipated by the '356 patent and the '214 patent. Dependent claims 2-8 were rejected as being anticipated by one or both of the '356 patent and the '214 patent. These claims all depend from independent claim 1 or intervening dependent claims and are submitted to be patentable for at least the reasons set forth above in support of the patentability of independent base claim 1.

Claim 16 also stands rejected under 35 U.S.C. §102(b) as being anticipated by the '356 patent and the '214 patent. Claim 16 is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, amongst other features, a retractor including an inner wall surface and a lighting element including at least one wall member, "said at least one wall member being bendable to conform with said inner wall surface for frictional engagement therewith, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor." As will be discussed below, independent claim 16 is submitted to be patentable over the '356 patent and the '214 patent.

With regard to the '356 patent, for the same reasons indicated above in regard to claim 1, it does not disclose, teach or suggest frictional engagement of at least one wall member of the light transmitting member 2810 with the accessory device 2860. Moreover, since the '356 patent does not teach or suggest this feature, it also can not teach or suggest "frictional engagement sufficient to maintain a position" of the light transmitting member 2810 relative to the accessory device 2860. Therefore, claim 16 distinguishes the '356 for at least these reasons. Moreover, claim 16 is submitted as patentable over the '214 patent for at least the reasons

supporting the patentability of claim 1 as well. Specifically, the '214 patent does not disclose frictional engagement of at least one wall member of the tubular members 50, 51 and the retractor 10. Consequently, the '214 patent also does not disclose "frictional engagement sufficient to maintain a position" of the tubular members 50, 51 to the retractor 10. For at least these reasons, claim 16 also distinguishes the '214 patent.

Accordingly, the Applicants respectfully request withdrawal of the rejection of independent claim 16 as being anticipated by the '356 patent and the '214 patent. Dependent claims 17-21 all depend from independent claim 16 or intervening dependent claims and are submitted to be patentable for at least the reasons set forth above in support of the patentability of independent base claim 16.

As indicated above, claim 26 has also been rejected under 35 U.S.C. §102(b) as being anticipated by the '356 patent and the '214 patent. Claim 26 is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, amongst other features, a retractor including an inner wall surface and a lighting element including at least one wall member, "said at least one wall member frictionally engageable with said inner wall surface, wherein said lighting element is movable axially along said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface."

Claim 26 is submitted as patentable over the '356 patent and the '214 patent at least because the cited patents do not disclose that at least one wall member of the light transmitting member 2810 or the tubular members 50, 51 is frictionally engageable with the accessory device 2860 or the retractor 10, respectively, as discussed above in regard to claim 1. Moreover, neither of the patents discloses a lighting element "movable axially along said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface." Specifically, the '214 patent discloses that the tubular members 50, 51 are soldered to the blade 12 of the retractor 10. Therefore, it is respectfully submitted that the tubular members 50, 51 are not even movable axially relative to the retractor 10. Furthermore, the '356 patent does not disclose that member 2810 is movable axially relative to member 2860. To the contrary however, considering that the '356 patent

discloses mechanical or adhesive connectors for attaching the accessory device 2860 to the light transmitting member 2810, it is submitted that attachment member 2850 prohibits member 2810 from being axially movable relative to device 2860. If this rejection is maintained, the Applicants respectfully request citation(s) to the portion(s) of the '356 patent and the '214 patent disclosing this claimed feature.

For at least these reasons, claim 26 is submitted as patentable over the '356 patent and the '214 patent. Accordingly, the Applicants respectfully request withdrawal of the rejection of independent claim 26 as being anticipated by the '356 patent and the '214 patent. Dependent claims 27-31 all depend from independent claim 26 or intervening dependent claims and are submitted to be patentable for at least the reasons set forth above in support of the patentability of independent base claim 26.

Claim 36 also stands rejected under 35 U.S.C. §102(b) as being anticipated by the '356 patent and the '214 patent. Claim 36 is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, amongst other features, a retractor including an inner wall surface and a lighting element including at least one wall member, "said at least one wall member frictionally engageable with said inner wall surface, wherein said lighting element is movable circumferentially about said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface."

Claim 36 is submitted as patentable over the '356 patent and the '214 patent at least because the patents do not disclose that at least one wall member of the light transmitting member 2810 or the tubular members 50, 51 is frictionally engageable with the accessory device 2860 or the retractor 10, respectively, as discussed above in regard to claim 1. Moreover, neither of the patents discloses a lighting element "movable circumferentially about said inner wall surface of said retractor for repositioning said lighting element in said working channel while maintaining frictional engagement with said inner wall surface." Specifically, the '214 patent discloses that the tubular members 50, 51 are soldered to the blade 12 of the retractor 10. Therefore, it is respectfully submitted that the tubular members 50, 51 are not movable circumferentially relative to the retractor 10. Furthermore, considering that the '356 patent

discloses mechanical or adhesive connectors for attaching the accessory device 2860 to the light transmitting member 2810, it is submitted that member 2810 is not circumferentially movable relative to device 2860. If this rejection is maintained, the Applicants respectfully request citation(s) to the portion(s) of the '356 patent and the '214 patent disclosing this claimed feature.

Accordingly, claim 36 is submitted as patentable over the '356 patent and the '214 patent and the Applicants respectfully request withdrawal of the rejection of independent claim 36 as being anticipated by the '356 patent and the '214 patent. Dependent claims 37-41 all depend from independent claim 36 or intervening dependent claims and are submitted to be patentable for at least the reasons set forth above in support of the patentability of independent base claim 36.

Claim 46 also stands rejected under 35 U.S.C. §102(b) as being anticipated by the '356 patent and the '214 patent. Claim 46 has been amended and is directed to a surgical instrument for accessing and illuminating a space within a body of a patient, comprising, a retractor positionable with the body of the patient and including an inner wall surface defining a working channel therealong and a lighting element including a pair of wall members and at least one light transmitting element between said pair of wall members, said pair of wall members forming a concavely curved inner wall surface of said lighting element and an opposite convexly curved outer wall surface of said lighting element, said outer wall surface positionable along said inner wall surface of said retractor with said inner wall surface of said lighting element oriented toward and exposed to said working channel.

It is respectfully submitted that the '356 patent and the '214 patent do not disclose a lighting element with a concavely curved inner wall surface oriented toward and exposed to a working channel as that feature is set forth in claim 1. Likewise, the '356 patent discloses a light transmitting member 2810 with a circular cross-section, which, as best seen in FIG. 28B, includes a convexly curved outer surface 2802 which extends about member 2810 and is exposed to the working channel provided by accessory device 2860. However, concavely curved inner surface 2804 is not exposed to the working channel. With regard to the '214 patent, it does not disclose that either of the members 50, 51 includes a pair of wall members. Moreover, the concavely curved inner surface of the tubular members 50, 51 is not exposed to the working

channel provided by retractor 10. Instead, the convexly curved outer surface of the members 50, 51 encircles the concavely curved inner surface and prohibits exposure thereof.

For at least these reasons, claim 46 is submitted as patentable over the '356 patent and the '214 patent. Accordingly, the Applicants respectfully request withdrawal of the rejection of independent claim 46 as being anticipated by the '356 patent and the '214 patent. Dependent claims 47-49 all depend from independent claim 46 or intervening dependent claims and are submitted to be patentable for at least the reasons set forth above in support of the patentability of independent base claim 46.

35 U.S.C. §103(a) Rejections

As indicated above, claim 4 was rejected under 35 USC §103(a) as being unpatentable over the '356 patent in view of the '393 patent. Claim 4 depends directly from claim 1, and is allowable at least for the same reasons claim 1 is allowable. Accordingly, withdrawal of this basis of rejection of this claim is respectfully requested.

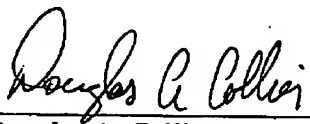
Claims 9-14, 22-24, 32-34 and 42-44 stand rejected under 35 USC §103(a) as being unpatentable over the '356 patent alone. These claims depend either directly or indirectly from independent claims 1, 16, 26, and 36 and are allowable at least for the same reasons claims 1, 16, 26, and 36 are allowable. Furthermore, the Examiner asserts that it would have been an obvious matter of design choice to modify the '356 patent to arrive at the subject matter of these claims. However, the Examiner has not provided any reference that teaches or suggests the desirability of the modification to the '356 patent as proposed by the Examiner. Rather, it appears that the only motivation for modifying the '356 patent is from the teachings in Applicant's specification in the present application. If the teaching in Applicant's own specification has not been relied upon, then citation of a reference that teaches or suggests the desirability of modifying the '356 patent render claims 6, 46 and 57 as obvious is respectfully requested. Alternatively, if the rejection is based on facts within the personal knowledge of the Examiner, then an affidavit providing the same is requested so the rejection can be considered and traversed if appropriate. Accordingly, withdrawal of this basis of rejection of these claims is respectfully requested.

As indicated above, claims 15, 25, 35 and 45 were rejected under 35 USC §103(a) as being unpatentable over the '356 patent in view of the '863 patent. Claims 15, 25, 35 and 45 depend directly from independent claims 1, 16, 26, and 36, respectively, and are allowable at least for the same reasons claims 1, 16, 26, and 36 are allowable. Accordingly, withdrawal of this basis of rejection of these claims is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance with pending claims 1-49. Reconsideration of the present application as amended is respectfully requested. Timely action towards a Notice of Allowance is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:

By: 
 Douglas A. Collier
 Reg. No. 43,556
 Krieg DeVault LLP
 2800 One Indiana Square
 Indianapolis, Indiana 46204-2079
 Phone: (317) 238-6333